

REMARKS

Claims 1-10 were examined and reported in the Office Action. Claims 1-3, 7 and 10 are rejected. Claims 4, 8 and 9 are cancelled. Claims 1-3, 5-7 and 10 are amended. New claims 11-13 are added. Claims 1-3, 5-7 and 10-13 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 103

It is asserted in the Office Action that claims 1-3, 7, and 10 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 5,709,151 issued to Dürr et al. ("Dürr") in view of GB 2 279 909A issued to Dennstedt ("Dennstedt"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "All words in a claim must be considered in judging the patentability of that claim against the prior art." (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's amended claim 1 contains the limitations of "[a] plate changing apparatus for changing a printing plate on a plate cylinder in a printing machine for

printing upon sheets being conveyed through the printing machine, the apparatus comprising: a loader supported by a frame to be movable substantially parallel to a sheet convey direction and serving to feed a new plate to the plate cylinder; loader moving means for moving said loader between a wait position where the loader is set to a substantially vertical state close to the plate cylinder, from a retreat position where the loader is set to a substantially vertical state away from the plate cylinder, and a plate feed position where the loader is set to an inclined state where a distal end of the loader holding the new plate is positioned close to the plate cylinder; and a plate removal unit fixed to the frame to recover an old plate discharged from the plate cylinder."

Dürr discloses a device for mounting, removing and transporting a printing plate. Dennstedt discloses a printing machine for automatic changing of printing plates. Neither Dürr nor Dennstedt, however, has disclosed, taught or suggested that the position of a loader changes according to the position of the loader (the relationship between a wait position, a retreat position, a plate feed position and the position of the loader. According to Applicant's claimed invention, since the loader is set (i.e., turns) to be positioned in a substantially vertical state in a wait position and a retreat position, the work space (i.e., the space by the opposite side of the plate cylinder of the loader [the retreat-position side of the loader]) when the loader is in a wait position, and the space by the side of the plate cylinder of the loader (including the space between the loader and the plate removal means when the loader is in a retreat position) are fully secured. Therefore, improved workability is facilitated. Additionally, when the loader is in a retreat position, access to the inside of the printing unit becomes easy. This improves tasks during maintenance inspection.

Therefore, neither Dürr, Dennstedt, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's amended claim 1, as listed above. Since neither Dürr, Dennstedt, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's amended claim 1 is not obvious over Dürr in view of Dennstedt since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that

directly or indirectly depend from amended claim 1, namely claims 2-3, 7 and 10, would also not be obvious over Dürr in view of Dennstedt for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for Claims 1-3, 7, and 10 are respectfully requested.

II. Allowable Subject Matter

Applicant notes with appreciation the Examiner's assertion that claims 4, 6 and 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has added new claims 11, 12 and 13, which correspond to claims 4, 8 and 9, respectively, re-written independent form, including all of the limitations of the base and intervening claims.

Applicant respectfully asserts that claims 1-3, 5-7 and 10-13, as they now stand, are allowable for the reasons given above.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-3, 5-7 and 10-13 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on October 12, 2004.


Jean Svoboda